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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,902	03/15/2004	Robert L. Turk	13615.60	1473

7590

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EXAMINER

DURAND, PAUL R

ART UNIT PAPER NUMBER

3721

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Applicant(s)	Applicant(s)	
	10/800,902	TURK, ROBERT L.	
	Examiner	Art Unit	
	Paul Durand	3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 16, 22-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 16 and 22-24 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

***Election/Restrictions***

1. Newly submitted claims 16 and 22-24 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the original claims do not rely on the patentably distinct limitations of the use of a "C" clip and the intended use of the cylinder head and restraining member.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 16 and 22-24 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-15 and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nikolich (US 4,403,722) in view of Schubert et al (US 4,568,243).

In regard to claims 1,3,6,9,11,12 and 19, Nikolich discloses the invention substantially as claimed including a combustion powered tool 10, fan 51, motor 61 substantially in the cylinder head 25, a one piece suspension mechanism or mount in

Art Unit: 3721

the form of resilient member 65, comprised of an inner ring shaped edge (no number given), secured and in direct contact to the motor, an outer ring shaped edge (no number given) secured to the cylinder head 25, and ring shaped retainer in the form of arcuately shaped cap 66 (see Fig. 2 and C9,L24-35). What Nikolich does not disclose is the suspension being manufactured from an elastic and elastomer material.

However, Schubert teaches that it is old and well known in the art of fan suspensions to provide a elastic element 56 manufactured from an elastomer material, with inner an outer frames manufactured from a stiffer elastomer material for the purpose of isolating vibrations (see Figs. 2,4,5,6 and C3,L45 – C4,L21). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the invention of Nikolich with the suspension means as taught by Schubert for the purpose of isolating vibrations.

In regard to claims 2,4 and 13, Nikolich discloses the invention substantially as claimed including a suspension mechanism 65, mounted between the fan motor and the cylinder head, and projects radially from the fan motor (see Fig.2).

In regard to claims 5 and 10, Nikolich discloses the invention substantially as claimed including a suspension mechanism 65 that is an integral piece (see Fig.2)

In regard to claims 7 and 14, the modified invention of Nikolich discloses the invention substantially as claimed as applied to claims 1 and 9 above, including a ring shaped retaining cap 66, which secure resilient member 65 to the cylinder head. What the modified invention of Nikolich does not disclose is the use of a snap ring to secure the suspension ring to the cylinder head. However, the examiner takes Official Notice

Art Unit: 3721

that it is old and well known in the art to provide a snap ring or a retaining ring to hold an object inside a recess for the purpose of preventing the accidental removal of the object. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the modified invention of Nikolich with a snap or retaining ring instead of a ring shaped retaining cap for the purpose of preventing the accidental removal of the suspension mechanism.

In regard to claims 8 and 15, Nikolich discloses the invention substantially as claimed including a ring shaped retainer in the form of arcuately shaped cap 66 (see Fig. 2).

In regard to claims 17 and 18, Nikolich discloses the invention substantially as claimed including a combustion powered tool 10, fan 51, motor 61, substantially in the cylinder head 25, a one piece suspension mechanism or mount in the form of resilient member 65, comprised of an inner ring shaped edge (no number given), secured, projecting radially and in direct contact to the motor, mounted between the fan motor and the cylinder head, an outer ring shaped edge (no number given) secured to the cylinder head 25, and ring shaped retainer in the form of arcuately shaped cap 66 (see Fig. 2 and C9,L24-35). What Nikolich does not disclose is the suspension being manufactured from an elastic and elastomer material. However, Schubert teaches that it is old and well known in the art of fan suspensions to provide a elastic element 56 manufactured from an elastomer material, with inner an outer frames manufactured from a stiffer elastomer material for the purpose of isolating vibrations (see Figs. 2,4,5,6 and C3,L45 – C4,L21). Therefore, it would have been obvious to one having ordinary

Art Unit: 3721

skill in the art at the time the invention was made to have modified the invention of Nikolich with the suspension means as taught by Schubert for the purpose of isolating vibrations.

In regard to claim 20, Nikolich discloses the invention substantially as claimed including a combustion powered tool 10, fan 51, motor 61, substantially in the cylinder head 25, a one piece suspension mechanism or mount in the form of resilient member 65, comprised of an inner ring shaped edge (no number given), secured and in direct contact to the motor, an outer ring shaped edge (no number given) secured to the cylinder head 25, and ring shaped retainer in the form of arcuately shaped cap 66 (see Fig. 2 and C9,L24-35). What Nikolich does not disclose is the suspension being manufactured from an elastic and elastomer material. However, Schubert teaches that it is old and well known in the art of fan suspensions to provide a elastic element 56 manufactured from an elastomer material, with inner an outer frames manufactured from a stiffer elastomer material for the purpose of isolating vibrations (see Figs. 2,4,5,6 and C3,L45 – C4,L21). Furthermore, the examiner takes Official Notice that it is old and well known in the art to provide a snap ring or a retaining ring to hold an object inside a recess for the purpose of preventing the accidental removal of the object. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the invention of Nikolich with the suspension means as taught by Schubert and a retaining means for the purpose of isolating vibrations and retaining a part.

In regard to claim 21, Nikolich discloses the invention substantially as claimed including a ring shaped retainer in the form of arcuately shaped cap 66 (see Fig. 2).

### ***Response to Arguments***

4. Applicant's amendment to the specification in regard to priority is noted and accepted.
5. Applicant's arguments filed 11/1/2004 have been fully considered but they are not persuasive.

Applicant argues that the primary reference of Nikolich does not show the motor substantially within the cylinder head. The examiner disagrees with this argument. In Figure 2, Nikolich clearly shows the motor mounted to the cylinder head itself with the fan portion and what appears to be at least half of the body inside the cylinder area itself. Furthermore, the exact meaning of "substantially" is itself vague. It could mean most of something, or a visually sufficient amount. In either case, the examiner contends that Nikolich falls within either of these broad definitions.

Applicant further argues in regard to claims 2 and 17, that Nikolich does not teach the applicant's invention since the elastic member is not connected directly to the motor and cylinder head. The examiner disagrees with this argument. From figure 2, it appears that bracket 62 is part of the motor housing, with its sole purpose of holding the retaining member. While figure 9 does show an alternative embodiment of the tool design, the examiner asserts that figure 2 teaches the claimed limitation.

Art Unit: 3721

Applicant further argues regarding claims 1 and 7 that it is not obvious to combine the a metal clip in lieu of the restraining member. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the use of a clip is just another old well known way to secure an item onto an assembly, and it is also well known to utilize a clip in lieu of a bolted on member.

Therefore for the reasons indicated above, the rejection is deemed proper.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



Art Unit: 3721

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Durand whose telephone number is 571-272-4459.

The examiner can normally be reached on 0730-1800, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Durand  
January 6, 2005

  
EUGENE KIM  
PRIMARY EXAMINER